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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/318,353	05/25/99	CASAGRANDE C	38916/14140

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EXAMINER	
HENDERSON, M	
ART UNIT	**PAPER NUMBER**
3722	6

DATE MAILED: 03/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/318,353	Charles L. Casagrande
Examiner	**Group Art Unit**
Mark T. Henderson	3722

☒ Responsive to communication(s) filed on *Dec 22, 2000*.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-24* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-12, 14-18, and 21-24* is/are rejected.

☒ Claim(s) *13, 19, and 20* is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *6*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. The drawings and specification have been amended to overcome the previous objections. Claim 6 and 7 have been amended to overcome the previous 112 rejections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1, 3, 11, 12, 14, 16 and 24 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Popat et al (5,662,976).

Popat et al discloses in Fig. 4 and 7, a form with integrated label comprising a form layer (60) having a top surface (A) and a bottom surface (62) and a periphery, at least one die cut (68 and 70) through the top and bottom surfaces within the periphery of the form layer defining at least one portion (portion of 60 between 68 and 70) or card intermediate, a patch layer (80) having mirror imaged first and second halves (as seen in Fig. 7)divided by a perforation line (82), a periphery and composed of translucent material, top surfaces (80a) and bottom surface (80b), a layer of repositionable, peelable adhesive (58), wherein the bottom surface of the patch layer is adhesively but removably secured (due to release coating 64) to the top surface of the form layer over the entire die cut and form layer portion in which the patch layer, adhesive layer and form layer comprising an integrated label (as seen in Fig. 7). and wherein the adhesive layer has a greater affinity for the bottom surface of the patch layer than the top surface of the form layer such that when the label (as seen in Fig. 7) is removed from the form, the portion of the adhesive layer (portion on left side of die cut 72 and left side of 68 as seen in Fig. 4) that is not between the patch layer and the form layer portion (portion of 60 between 68 and 70) is exposed and stays adhered to the bottom surface of the patch layer (this can also be seen in Fig. 3, top portion wherein when the label is lifted, the exposed adhesive can be seen around the die-cut perimeter),

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 2, 10, 15, 21, 22 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al in view of Blum et al (4,204,706).

Popat et al discloses in Fig. 4, 5 and 7, a form with integrated label comprising all the elements as claimed in Claim 1, 11 and 12 and as set forth above. Popat also discloses the bottom surface (62) of the form layer being able to accept indicia.

However, Popat et al does not disclose the top surface of the patch layer and the top surface of the form layer being able to accept indicia.

Blum et al discloses in Fig. 2 and Col. 3, lines 50-56, a form with integrated label having a patch layer (19) and a form layer (17) in which indica can be accepted on the top surfaces thereof through the use of "spot carbonized" method , so that when marking pressure is applied to the outer top surface of the patch layer, a corresponding ink mark is produced on the top surface of the form layer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Popat et al's form to include "spot carbonization as taught by Blum et al for the purpose of eliminating the requirement that the patch be folded back to permit marking of indicia on the form surface.

4. Claims 4-7, 9, 17, 18 and 23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al.

Popat et al discloses in Fig. 4, 5 and 7, a form with integrated label comprising all the elements as claimed in Claim 1, 11 and 12 and as set forth above. Popat also discloses a patch layer sized and offset in relation tot he die cut in the form layer such that a distance between an edge (76A) of the patch layer and a corresponding edge of the form layer (70A) is greater than that between other corresponding edges.

However, Popat et al does not disclose: a patch layer composed of translucent paper glassine, translucent polyester film, opaque material; sized and offset in relation to the die cut in the form layer such that the distance between an edge of the patch layer and a corresponding edge of the from layer portion is less than that between other corresponding edges; the form layer contains multiple die cuts therein defining multiple portions of the form layer.

In regards to **Claims 4-6, 17, 18**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the patch layer in any desirable material, since it has been held to be within the general skill of a worker in the art to select a known

material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 7**, it would have been an obvious matter of design choice to construct the patch layer in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

In regards to **Claim 9 and 23**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any number of die cuts, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

5. Claim 8 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al in view of Stipek (3,914,483).

Popat et al discloses in Fig. 4, 5 and 7, a form with integrated label comprising all the elements as claimed in Claim 1 and as set forth above.

However, Popat does not disclose an integrated label containing a second label comprising portions of the patch within a second die cut extending through the patch layer and to, but not through the form layer portion, wherein the second label is removable.

Stipek discloses in Fig. 5 and 6, an integrated label (51) containing a second label (33) comprising portions of the patch and adhesive layers within a second die cut (53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Popat et al's form to include a label within a label as taught by Stipek for the providing a way in which an inner label can be removed from the main label after it is affixed to a container with the inner label being easily attachable to containers.

Allowable Subject Matter

6. Claims 13, 19 and 20 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed on December 22, 2000 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a patch layer that is void of die cuts that leaves behind material upon removal of the card from the form and a

form that is void of releasing agents allowing for recycling of the form) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Popat et al reveals a form having a form layer and a patch layer, wherein within the form and patch layer there is an integrated label, wherein when the label is removed from the form, leftover adhesive is exposed.

In response to applicant's argument that the Popat et al reference does not disclose a form that is void of releasing agents allowing for recycling, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

MTH

March 8, 2001

A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700